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10/763,374	01/23/2004	Ernst Mauch	20020/10018	7574

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EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/763,374

Applicant(s)

MAUCH ET AL.

Examiner

Bret C. Hayes

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) 3-19, 21 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 20, 22, 26, 27 and 35-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Species A, 1, f has been elected and claims 1, 2, 20, 22 – 27 and 35 – 37 have been indicated as readable on the elected invention. Were one to more carefully read the *election* requirement, one would understand that this is erroneous, as discussed below. The election was made with traverse as to the appropriateness of the election requirement. In response, examiner will attempt to elucidate any obfuscation for the edification of the Applicants.
2. Restriction practice is proper anytime before final action – see MPEP 802, which states, among other things, “37 CFR 1.141. Different inventions in one national application. (a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.”, (*examiner’s emphasis added*) and, “37 CFR 1.142. Applicant argues the requirements for restriction, however, the requirement was for an election of species pursuant to 808.01. Note that requirements for restriction are outlined in 808.02. Regarding 1.141, a seventeen-way election of species, as asserted by Applicants, would appear to be in excess of the reasonable number of species as outlined above. If applicant admits that any of the species are obvious variants on the elected species, the requirement for that species will be withdrawn.
3. Regarding 1.142, because the election requirement has been made before final action, the election of species, although inconvenient, is proper.

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4. Regarding 802.01, “limitations” such as ‘to prevent firing’ *are not usable together as disclosed* with “limitations” such as ‘to permit firing’. As such, only one or the other need be examined on the merits at this time.

5. Regarding the issue of the claims being readable on the elected species, for the record, the species elected is defined as:

A: a firearm comprising a housing, a safety, a first module containing an electronic identification device (EID) identifying a first authorized user, the EID controlling the safety to prevent firing by unauthorized persons and to permit firing by the first authorized user, and a second module, interchangeable with the first, and interacting with the safety;

l: prevent firing by all persons; and,

f: further comprising a contact sensor, which activates the safety.

However, due to amendment, claim 1 now reads, “a firearm comprising a housing, a safety, a first module containing an electronic identification device (EID) identifying a first authorized user, the EID controlling the safety to prevent firing by unauthorized persons and to permit firing by the first authorized user,” with no apparent “second module” to be found.

It would appear that the Applicants have attempted to amend the claims around the election requirement. Interestingly enough, there is absolutely no mention of a “blank module” above, which was species “B” of the election requirement when compared with “a second module”. The rationale for this is that “a second module” implies a certain similarity to or relationship with “a first module”, whereas “a blank module” implies no such similarity to or relationship with “a module”, but rather, a certain dissimilarity and lack of relationship, or, an opposite design of operation or effect as defined above.

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Given the above, claims 23 – 25 have been withdrawn as being drawn to an unelected species.

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*Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1, 22, 26, 35 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation, “a rear grip element”, which lacks antecedent basis, as there is no previous recitation of ‘a rear grip’ of which there can be ‘an element’, for example. Also, there is no basis throughout the remainder of the claims to distinguish a “rear” grip from any other grip.

9. Re – claim 26, the use of the term “if” makes the claim unclear as it presents a conditional statement into supposedly definite structural limitations. See the section following paragraph 12 for the difference between an apparatus claim and a method of operation claim. Further, the term "dropped" in the claim is a relative term, which renders the claim indefinite. The term "dropped" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. How far would the firearm need to ‘drop’ in order to activate the safety as conditionally ‘required’.

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10. Claims 22, 35 and 37 are rejected as being ultimately dependent upon claim 1.

Additionally it is noted that the claims are directed to an apparatus per se, not a method of operation. However, the claims (e.g. claim 1) contain limitations concerning the method/manner of forming a rear grip element, identifying a first authorized user, controlling the safety, preventing and permitting firing, and attaching the first module to the handle.

Note that it is well settled case law that such limitations, which are essentially method limitations or statements of intended or desired use, do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 152 USPQ 235; *In re Otto*, 136 USPQ 458; and, *Ex parte Masham*, 2 USPQ2d 1647.

See MPEP 2114, which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of the structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

and,

Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

11. For those reasons, limitations within the body of the claims regarded as a ‘method of operation’ or an ‘intended or desired use’ cannot and will not be given patentable weight.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, 20, 22, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,570,528 to Teetzel.

14. Re – claim 1, Teetzel discloses the claimed invention including a firearm **70** comprising a housing having a handle, best seen in Fig. 1, for example, a safety **48**, for example, a first module **12** removably attachable to the handle, as set forth at col. 3, line 41+, for example, the first module **12** containing an electronic identification device (*EID*), see Fig. 3, for example, the *EID* operatively connected to the safety **48**.

15. Re – claim 2, Teetzel discloses further comprising a memory, as set forth at col. 3, lines 54 – 60, col. 4, lines 28 – 37, and col. 4, lines 61 – 65, for example. While examiner concedes that there is no explicit mention of the term “memory”, it would be inherent in the device as the only way for a voice recognition chip to authenticate an operator’s speech pattern as disclosed would be to compare a pattern given with one stored. Stored where? In a memory.

16. Re – claim 20, Teetzel discloses the claimed invention as applied above. The recitation “the memory stores...” has not been given patentable weight because it is functional language, narrative in form, a method of operation of the device and does not structurally distinguish from the prior art of record. Therefore, Teetzel discloses the memory as claimed. Further, the memory need only be capable of performing the intended use, which it is.

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17. Re – claim 22, the recitation “when the first module is removed from the firearm” has not been given patentable weight because it is functional language, narrative in form, a method of operation of the device and does not structurally distinguish from the prior art of record.

Therefore, Teetzel discloses the safety operative to prevent firing as claimed.

18. Re – claim 26, Teetzel discloses the claimed invention including a contact sensor 18, which activates the safety 48. While Teetzel does not call microphone 18 a contact sensor, in every imaginable circumstance except for the firearm being ‘dropped’ in a vacuum, the microphone would ‘sense’ the ‘contact’ of the firearm via sound wave propagation.

19. Re – claim 27, Teetzel discloses the claimed invention including wherein the firearm has a firearm identification number. It is inherent that all firearms have identification numbers. This is a matter of law. Regarding the recitation “the...number is written to the memory” has not been given patentable weight because it is functional language, narrative in form, a method of operation of the device and does not structurally distinguish from the prior art of record.

Therefore, Teetzel discloses the safety operative to prevent firing as claimed.

### ***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teetzel alone.



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22. Re – claim 37, Teetzel discloses the claimed invention except for further comprising a second module interchangeable with the first module such that the first and second modules re interchangeable. Eli Whitney is generally regarded as the father of interchangeable parts.

Coincidentally, his interchangeable parts were for muskets (a type of firearm used in the late 18<sup>th</sup> century). Since that time, it has been understood that the provision of interchangeability, where needed, involves only a matter of routine skill in the art.

23. Alternatively, Teetzel discloses the claimed invention except for a second module removably attachable to the handle in place of the first module. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a second module removably attachable in place of a first module, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

24. Re – claim 35, Teetzel discloses the invention as claimed as applied above. The recitation that the second module “is incapable of releasing the safety” merely limits the claim to an inoperative second module, which only needs to be capable of performing the intended use. As such, were one to discover that another module was defective and not operating as intended, one would obviate the claimed invention.

25. Re – claim 36, Teetzel discloses the invention as claimed as applied above. See above with respect to method of operation and/or intended use. The second module “releasing the safety” is just such a limitation.

*Response to Arguments*

26. Applicant's arguments with respect to claims 1- 27 and 35 – 37 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902. The examiner can normally be reached Monday through Friday from 5:30 am to 2:00 pm, Eastern Standard Time.

On July 15, 2005, the Central FAX Number was changed to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for “centralized delivery”.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (571) 272 – 7045.

bh

3-Oct-05

  
MICHAEL J. CAFONE  
SUPERVISORY PATENT EXAMINER